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Paper No. 7

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NOV 29 2001

In re Application of	:	<b>OFFICE OF PETITIONS</b>
Glenn McGarry	:	
Application No. 09/764,782	:	DECISION REFUSING STATUS
Filed: 17 January, 2001	:	UNDER 37 CFR 1.47(a)
Attorney Docket No. 2785.100	:	

This is in response to the petition filed under 37 CFR 1.47(a) on 15 October, 2001.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

**FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.** Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified application was filed on 17 January, 2001, without an executed oath or declaration. Accordingly, on 7 May, 2001,<sup>1</sup> a Notice to File Missing Parts of Nonprovisional Application was mailed, requiring a signed oath or declaration and a surcharge for its late filing. In response, on 15 October,

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<sup>1</sup>It is noted that the Notice to File Missing Parts contained in the official file shows a mailing date of 7 March, 2001. Apparently, the actual Notice sent to applicant was mailed on 7 May, 2001, however.

2001 (certificate of mailing date 9 October, 2001), the present petition was filed, accompanied by a request and payment of the fee for a three (3) month extension of time, a declaration naming Glenn McGarry and Wesley Fedorchak as joint inventors and signed by joint inventor McGarry on behalf of himself and joint inventor Fedorchak, and payment of the petition fee and surcharge.

Petitioners assert that Fedorchak has refused orally to sign the declaration.

A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee;
- (4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and
- (5) a statement of the last known address of the non-signing inventor.

The petition lacks item (1). In regards to item (1), petitioners have not submitted sufficient evidence to prove that a copy of the application was sent or given to the non-signing inventor. Petitioners must show proof that a copy of the application (specification including claims, drawings, if any, and the Declaration) were sent or given to the non-signing inventor for review.<sup>2</sup> Petitioners should provide a copy of the cover letter transmitting the application papers to the non-signing inventor or details given in an affidavit or declaration of facts by a person having first hand knowledge of the details.

The declaration of registered patent attorney Douglas Sharott, in which attorney Sharott states that a copy of the application was sent to Fedorchak, is not sufficient to show that a copy of the application was mailed because it is unclear whether Sharott has first-hand knowledge of the mailing. Petitioners should provide a copy of the cover letter transmitting the application papers (specification, including claims, drawings, if any, and the declaration) to the non-signing inventor or details given in affidavit or declaration of facts by a person having first hand

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<sup>2</sup> MPEP 409.03(d).

knowledge of the details.

Petitioners must also present proof that the non-signing inventor refuses to sign the declaration after being sent or given a copy of the application papers. If there is a written refusal, a copy of the written refusal should be submitted with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of facts.

Additionally, it is noted that the mailing address listed in the declaration for both joint inventors is 1 World Trade Center, 38th Floor, New York, NY. In view of the terrorist attacks on September 11, 2001, it is obvious that this is no longer a valid address. Petitioners should submit a new oath or declaration listing the current mailing addresses for the inventors.


Further correspondence with respect to this matter should be addressed as follows:

By mail:           Assistant Commissioner for Patents  
                    Box DAC  
                    Washington, D.C. 20231

By FAX:           (703) 308-6916  
                    Attn: Office of Petitions

By hand:           Crystal Plaza Four, Suite 3C23  
                    2201 S. Clark Place  
                    Arlington, VA

Telephone inquiries related to this decision should be directed to the undersigned at 703-308-6918.

  
Douglas I. Wood  
Petitions Attorney  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy